AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE   Page 10
Serial Number: 09/893,187   Dkt: 2213.001US1
Filing Date: June 27, 2001
Title: SYSTEM AND METHOD FOR OVER THE AIR PROGRAMMING

REMARKS

This responds to the Office Action dated on October 17, 2005.

Claims 10, 18, 21, 28, 44 and 47 are amended. Claims 10, 12-23, 28-30 and 35-50 are now pending in this application.

Interview Summary

Since the previous amendment after final was not entered, the interview summary is repeated herein. Applicant wishes to thank the Examiner for the courtesies extended during a telephone interview November 30, 2005. The interview included Examiner Wayne Cai, Bradley A. Forrest and Vikas Jain. We discussed claims 10, 21 and 37 with respect to art used to reject them in the Final Office Action. No exhibits were presented, and no agreement was reached.

§103 Rejection of the Claims

Claims 10, 12-23, 28-30, 35, 37-49, and 52-55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman (U.S. Patent No. 6,622,017B1) in view of McAlinden (U.S. Publication No. 2002/0193101A1). This rejection is respectfully traversed. Selected independent claims have been amended to make it clear that code is first downloaded to a first memory, then the device is rebooted, the code is detected during the reboot, and then it is burned into the programmable memory. This multiple step download process is clearly not shown in the references, and such a multiple step download process with a reboot prior to loading code into a memory different from the memory where it is received is not shown or suggested in any of the references, alone or combined. Each of the other independent claims rejected under this combination of references also describe such a multiple step process of receiving code in one memory and then writing following reboot into a memory from which it will execute. Claims 18 – 23, 28 – 30, and 44 – 49 also recite two reboots or restarts of the computer for the code to be properly written to the correct memory. This is also clearly not shown in the references alone or combined.

McAlinden is cited as teaching rebooting after receipt of the complete software package in paragraph [0027]. While McAlinden may reboot or reinitialize to have software take effect, it

does not appear to reboot to load it from one memory into another memory as claimed. The

Office Action stated that McAlinden disclosed <u>prior to writing the computer code</u>, initiating a

reboot [0027]. This is not what that paragraph says. It recites initializing the device with the

configuration information, and then rebooting for it to take effect. It appears to describe that the

configuration information is first written, and then the device is rebooted. It does not appear to

describe rebooting and then writing the configuration information as claimed. Most likely, the

reboot occurs so that programs in McAlinden can read parameters from the configuration

information and modify the way that it operates. If no reboot occurred, operation would

continue as though the previous parameters were still in effect. It is likely not done to transfer

code from one memory to another as claimed.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of

obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do

that the Examiner must show that some objective teaching in the prior art or some knowledge

generally available to one of ordinary skill in the art would lead an individual to combine the

relevant teaching of the references. *Id.*

The *Fine* court stated that:

> Obviousness is tested by "what the combined teaching of the references
> would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d
> 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by
> combining the teachings of the prior art to produce the claimed invention, absent
> some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732
> F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined
> *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

> In order for the Examiner to establish a *prima facie* case of obviousness,
> three base criteria must be met. First, there must be some suggestion or
> motivation, either in the references themselves or in the knowledge generally
> available to one of ordinary skill in the art, to modify the reference or to combine
> reference teachings. Second, there must be a reasonable expectation of success.
> Finally, the prior art reference (or references when combined) must teach or
> suggest all the claim limitations. The teaching or suggestion to make the claimed
> combination and the reasonable expectation of success must both be found in the
> prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re
> Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

The references must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). As indicated above, McAlinden fails to teach rebooting to cause code to be written from one memory to another as claimed. Thus, neither McAlinden nor Hoffman, alone or combined teach or suggest the invention as claimed. A proper prima facie case of obviousness has not been established, and the rejection should be withdrawn.

Claim 36 was were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman (U.S. Patent No. 6,622,017B1), in view of McAlinden (U.S. Publication No. 2002/0193101A1), and in further view of Marran (U.S. Patent No. 6,549,770B1). Claim 36 depends from claim 35 and is believed patentable for at least the same reasons.

Claims 50-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marran (U.S. Patent No. 6,549,770B1), and in view of Shaw (U.S. Patent No. 6,341,373B1), and in further view of McAlinden (U.S. Publication No. 2002/0193101A1). The rejection is respectfully traversed.

Claim 50 recites a process similar to claim 10, where a reboot is performed prior to burning the code into flash memory where it will execute from. None of the references show such a two step process. McAlinden is cited as having a reboot routine in paragraph 0027 that directs a reboot when the detection module detects the complete software update. However, such a reboot does not cause code to be written from one memory to another as claimed. McAlinden appears to describe storing configuration information. The rebooting in McAlinden allows

programs to read that configuration information in order to run. The configuration information is not burned into a flash memory after the reboot starts as claimed in claim 50. Thus, the rejection does not establish a proper prima facie case of obviousness since each and every element of the claimed invention is not shown or suggested by the combination of references. The rejection should be withdrawn.

Claim 51 similarly describes a reboot routine that results in a burner routine that burns the update from a receiver that receives the software packets to a flash memory. As in claim 50, the references do not teach or suggest such elements, and the rejection should be withdrawn.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6972 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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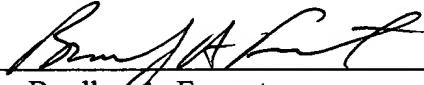
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JACLYN SKIBA

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